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**THIS DISPOSITION
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Paper No. 15
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Thyssen Hunnebeck GmbH

Serial No. 75/598,724

John A. Clifford and Kristina M. Foudray of Merchant & Gould P.C. for Thyssen Hunnebeck GmbH.

Zhaleh Sybil Delaney, Trademark Examining Attorney, Law Office 101 (Jerry Price, Managing Attorney).

Before Hairston, Chapman and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Thyssen Hunnebeck GmbH has filed an application to register the mark MANTO for "building assistance devices, namely prefabricated scaffolding and construction forms made of metal for erecting construction formwork" in Class 6 and "building assistance devices, namely prefabricated

scaffolding and construction forms made of plastic or wood for erecting construction formwork" in Class 19.¹

Registration has been finally refused on the ground that the proposed mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act. Both applicant and the Examining Attorney have filed briefs.² An oral hearing was not requested.

The Examining Attorney maintains that the primary significance of the term MANTO to the relevant public is that of a surname and that the term has no other readily recognizable meaning. As support for her position, she relies upon the results obtained from a search in the

¹ Serial No. 75/598,724, filed December 3, 1998 under Section 44(e), based on ownership of German Registration No. 1,075,937, issued April 12, 1985.

² The Examining Attorney has objected to the new evidence which applicant has attached to its brief (Exhibits A and B) as untimely. Applicant contends that it should be permitted to submit additional evidence in connection with its brief to challenge the Examining Attorney's supplementation of the record in responding to applicant's request for reconsideration.

The Examining Attorney's objection is proper and no consideration has been given to the exhibits attached to applicant's brief. Under Trademark Rule 2.142(d) the record must be complete prior to the filing of an appeal. If applicant files a request for reconsideration at the time of appeal, the case will be remanded to the Examining Attorney for further consideration and at this point the Examining Attorney is free to include additional evidence in support of his/her position, if the refusal is maintained. See TMEP § 1105.04(f). The prosecution ends at this point, however, and applicant is allowed no further opportunity to introduce new evidence, absent a further request for remand. The appeal goes forward on the evidence of record. Neither applicant nor the Examining Attorney may introduce new evidence in connection with the briefs.

PHONEDISC POWERFINDER USA ONE 1998 (4th Ed.) database, in which a total of 113 listings for the surname "Manto" were found. In addition, she has made of record excerpts retrieved from two searches of the Nexis database³ showing use of the term as a surname, for the most part for the professional baseball player Jeff Manto, and pages from Webster's II New Riverside Dictionary and Webster's New Geographical Dictionary showing the absence of any ordinary or geographical meaning for the term.

Applicant argues that the Examining Attorney has not met the burden of demonstrating that MANTO is recognizable to the purchasing public as primarily merely a surname. Applicant notes that the Phonedisc search shows only 113 "Manto" surnames out of 115 million surnames and that the Nexis searches predominately identify a single person, namely Jeff Manto. Applicant contends that this is insufficient evidence to show that the average member of the purchasing public would recognize MANTO as a surname. Furthermore, applicant argues, the evidence shows that there are several other meanings for the term. Applicant points to the references in the Nexis evidence of record to

³ From the first search the Examining Attorney made of record the first 50 excerpts out of 3007 hits and from the second the first 150 excerpts out of 2394 hits.

the use of "Manto" or "Mantos" as a first name (12 references), of the word "Mantos" as part of a company name (2 names), of the term "mantos" or "manto" in connection with the description of a type of mineral formation (5 references), of "Manto" as the name of a place in England (5 references) and of "manto" as the name of an appetizer (1 reference). In addition, applicant has made of record dictionary evidence showing that "manto" means "mantle" or "cloak" in the Italian language. Thus, applicant argues, the evidence of record shows that MANTO is not primarily merely, or only, a surname.

A term is primarily merely a surname if its primary significance to the purchasing public is that of a surname. In *re Hutchinson Technology, Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988); In *re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988). The initial burden is on the Patent and Trademark Office to establish a prima facie case that the term is primarily merely a surname. In *re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985). As stated by our principal reviewing court, the question of whether a mark is primarily merely a surname can only be resolved on a case-by-case basis. In *re Etablissements Darty et Fils*, 225 USPQ at 653.

We find that the Examining Attorney has met the initial burden of establishing that the term MANTO would be viewed by the purchasing public as being primarily merely a surname. Despite the fact that there were only 113 listings for the surname in the Phonedisc and a minimal number of uses of the term as a surname in the Nexis evidence, other than as the name of the professional baseball player Jeff Manto, this is sufficient evidence to show the significance of the term as a surname, albeit relatively rare. Even a rare surname is unregistrable if its primary significance to purchasers is as a surname, and there is no minimum number of directory or telephone listings required to establish a prima facie case for refusal of registration under Section 2(e)(4). In re Cazes, 21 USPQ2d 1797 (TTAB 1992); In re Industrie Pirelli Societa per Azioni, *supra*.

Furthermore, although the telephone and Nexis references are limited, they do show that the public has been more than nominally exposed to the surname through the usage by a professional baseball player who has obtained widespread coverage in the publications covered by the Nexis searches. Thus, even if MANTO is a rare surname, this does not mean that its surname significance would not be recognized by a substantial number of persons throughout

the United States. See *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990)(although limited Nexis references, sufficient to show exposure of surname to persons throughout the country). The fact that there are no ordinary or geographical meanings for the term reinforces the surname significance of the term.

If the Examining Attorney makes of record credible evidence from which it can be determined that the primary meaning of the term sought to be registered is that of a surname, the burden shifts to the applicant to show that the term has another meaning which is well enough known to the public that it cannot be said that the primary significance of the term is as a surname. *In re Pohang Iron & Steel Co., Ltd.*, 230 USPQ 79 (TTAB 1986). Unless there is a readily recognized meaning for a term apart from its surname significance, the fact that other meanings for the term exist does not necessarily indicate that the term would have a primary meaning to the purchasing public other than that of its ordinary surname significance. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993).

We agree with the Examining Attorney that the meaning of the term "manto" in Italian is not a readily recognizable meaning to the general purchasing public in the United States. This is clearly not a meaning which

would be well enough known to detract from the primary significance of the term as a surname. Similarly, we do not find any of the other meanings advanced by applicant to be those which would be readily recognizable by the general purchasing public. In the first place, the term in question is "manto," not "mantos" and thus references to the latter are irrelevant. But even more importantly, the minimal usages which applicant points to are far from significant. The technical use of the term in reference to a type of mineral formation is obviously not a meaning recognized by the general public. The few references to a place or establishment in Manchester, England and the singular reference to an appetizer are far from substantive evidence of a readily recognized meaning on the part of the United States purchasing public. All in all, applicant's reliance upon an isolated number of Nexis references to "manto" in a manner other than a surname is far from adequate to carry its burden of showing that the term has another meaning which is well enough known to the public that it cannot be said that the primary significance of the term MANTO is as a surname.

Accordingly, we find that applicant has failed to rebut the Examining Attorney's showing that the primary

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significance to the purchasing public of the term MANTO is merely, or only, that of a surname.

Decision: The refusal to register under Section 2(e)(4) is affirmed.

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